REMARKS

The Office Action of April 9, 2010, has been received and reviewed. Claims 26, 28 through 33, and 36 through 39 are currently pending in the application. Claims 26, 28 through 33, and 36 through 39 stand rejected. Claims 1 through 25, and 40 through 112 are withdrawn from consideration. Applicants have amended claims 26 and 29 through 33, and respectfully request reconsideration of the application as amended herein.

Independent claim 26 is amended herein to recite, "A method of conducting a pari-mutuel gaming activity on a computerized parimutuel gaming system, the method comprising: providing at least one patron an opportunity to select at least one runner from a list of runners on a display element with an input device coupled to a computerized parimutual gaming system operatively configured with hardware and software; responsive to the at least one patron selecting the at least one runner with the input device, providing the at least one patron an opportunity to place at least one first wager on a race wherein the at least one runner makes up a portion of the at least one first wager; solely responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device; and displaying on the display element at least one indicia of a wager selected by the at least one patron." Support for the amendment is found in the as-filed specification at least at paragraphs [0060], [0068], and [00112] and FIGS. 24 and 33.

Dependent claims 29 through 32 are amended herein to improve antecedent basis in light of the amendments to independent claim 26.

Independent claim 33 is amended herein to recite, in part, "automatically responsive to the at least one patron placing the at least one first wager with the input device, the at least one patron is presented with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race displayed on the display element by selecting the at least one wager option with the input device." Support for the amendment is found in the as-filed specification at least at paragraphs [0068] and FIG. 24.

35 U.S.C. § 101 Non-Statutory Subject Matter

Claims 26 through 32 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection, as hereinafter set forth.

The Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101 provides a two part test for determining subject matter eligibility. The claimed invention (1) must be directed to one of the four statutory categories and (2) must not be wholly directed to subject matter encompassing a judicially recognized exception.

The four statutory categories are process, machine, manufacture, and composition of matter. If the claimed product is a machine, manufacture, or composition of matter, and does not recite judicially excepted subject matter, e.g., an abstract idea, a mathematical algorithm, a law of nature, or a natural phenomenon, it qualifies as eligible subject matter. The Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos provides factors to consider in determining whether a process claim is directed to an abstract idea and is therefore not patent eligible under 35 U.S.C. § 101. Factors weighing toward eligibility include: recitation of a machine or transformation (either express or inherent), the claim is directed toward applying a law of nature, and the claim is more than a mere statement of a concept. Factors weighing against eligibility include **no recitation of a machine or transformation (either express or inherent)**, insufficient recitation of a machine or transformation, the claim is not directed to an application of a law of nature, and the claim is a mere statement of a general concept.

Independent claim 26, as amended herein, is directed to a method of conducting a pari-mutuel gaming activity on <u>a computerized parimutuel gaming system</u> and recites "providing at least one patron an opportunity to select at least one runner from a list of runners <u>on a display element with an input device coupled to a computerized parimutual gaming system operatively configured with hardware and software</u>; responsive to the at least one patron selecting the at least one runner <u>with the input device</u>, providing the at least one patron an opportunity to place at least one first wager on a race wherein the at least one runner makes up a portion of the at least one first wager; solely responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner

24

and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device; and displaying on the display element at least one indicia of a wager selected by the at least one patron." Claim 1 is directed to a method of conducting a pari-mutuel gaming activity on a computerized pari-mutuel gaming system and includes various elements in which the gaming system must be programmed to perform. The gaming system must be programmed to provide at least one patron an opportunity select at least one runner from a list of runners on a display element with an input device, to provide the at least one patron with an opportunity to place at least one first wager on a race, to provide the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race, and to display on the display element at least one indicia of a wager selected by the at least one patron. Accordingly, the method of claim 26 is tied to a particular machine that includes a computerized parimutuel gaming system which implements the claimed steps. Claim 26 does not include a law of nature, and claim 26 is more than a mere statement of a concept as it provides a tangible implementation of a method of conducting a pari-mutuel gaming activity.

Claim 26 is also does not meet any of the factors weighing against eligibility. As previously discussed, Claim 26 adequately recites a machine, and claim 26 is not directed to an application of a law of nature or a general concept.

Because the method of claim 26 is tied to a particular machine and is not wholly directed to an application of a law of nature or a mere statement of a general concept, claim 26 is a patent-eligible method claim under 35 U.S.C. § 101.

Regarding claims 27 through 32, these claims depend from independent claim 26, which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 27 through 32 are allowable.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent Publication No. 2003/0125822 to LaNeve

Claims 26 through 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by LaNeve (U.S. Patent Publication No. 2003/0125822) hereinafter referred to as "LaNeve". Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Unless a single prior art reference describes "all of the limitations claimed" and "all of the limitations [are] arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN Inc. v. VeriSign Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). A single prior art reference must "clearly and unequivocally" describe the claimed invention "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *Id.* at 19 (citing *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972)).

LaNeve does not anticipate claims 26 and 28 through 32 because LaNeve does not expressly or inherently describe each and every element of independent claim 26. Specifically, LaNeve does not describe "solely responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device," as recited in claim 26, as amended herein. Rather, LaNeve describes that after the user selects the probable payout value on FIG. 4 corresponding to a wager type, the selection is then displayed to the user in the selection window 208 of FIG. 3, and the wager may be placed by the user by selecting the "SUBMIT" button displayed in the interface of FIG. 3. *LaNeve* at paragraph [0039]. Also, FIG. 5 of LaNeve illustrates an exemplary graphical user interface for providing information to a user

26

associated with races within a multiple race wager group. *Id.* at paragraphs [0044]-[0045]. FIG. 5 is shown with two selection windows 208 so that the wager from each race, required, for example, for a daily double wager, may be placed by the user *at the same time* by selecting the "SUBMIT" button. If a user in LaNeve wishes to place an additional wager on the race after submitting the first wager, the user will have to restart the wagering system. *See LaNeve* at FIG. 6 (illustrating that the wagering system of LaNeve stops after a first bet has been placed). By restarting the wagering system, the user in LaNeve will have to reenter the desired race, select the runner to view the probable payout information for the runner, select the desired probable payout value where it is upon the user to make sure that the same bet as the previous bet is not chosen, and then submit the second bet. Accordingly, the at least one wager option described in LaNeve is not *solely* responsive to the at least one patron placing the at least one first wager, but rather, requires the user to independently restart the wagering system and pick the same race parameters. Additionally, the wager option presented to the user in LaNeve will only include the at least one runner if the user chooses the same runner, not solely responsive to the user placing the first wager with the at least one runner. As such, LaNeve does not expressly or inherently describe solely responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device.

Since LaNeve does not expressly or inherently describe each and every element of claim 26, Applicant respectfully requests withdrawal of the anticipation rejection of this claim.

Regarding claims 28 through 32, these claims depend from claim 26 which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 28 through 32 are allowable.

LaNeve does not anticipate claims 33 and 35 through 39 because LaNeve does not expressly or inherently describe each and every element of independent claim 33. Specifically, LaNeve does not disclose "automatically responsive to the at least one patron placing the at least one first wager with the input device, the at least one patron is presented with at least one wager option including the at least one runner and an opportunity to place at least one second wager on

the race displayed on the display element by selecting the at least one wager option with the input device," as recited in claim 33, as amended herein. Rather, as previously discussed regarding claim 26, LaNeve describes that after the user selects the probable payout value on FIG. 4 corresponding to a wager type, the selection is then displayed to the user in the selection window 208 of FIG. 3, and the wager may be placed by the user by selecting the "SUBMIT" button displayed in the interface of FIG. 3. *LaNeve* at paragraph [0039]. Also, FIG. 5 of LaNeve illustrates an exemplary graphical user interface for providing information to a user associated with races within a multiple race wager group. *Id.* at paragraphs [0044]-[0045]. FIG. 5 is shown with two selection windows 208 so that the wager from each race, required, for example, for a daily double wager, may be placed by the user *at the same time* by selecting the "SUBMIT" button. If a user in LaNeve wishes to place an additional wager on the race after submitting the first wager, the user will have to restart the wagering system. *See LaNeve* at FIG. 6 (illustrating that the wagering system of LaNeve stops after a first bet has been placed). By restarting the wagering system, the user in LaNeve will have to reenter the desired race, select the runner to view the probable payout information for the runner, select the desired probable payout value where it is upon the user to make sure that the same bet as the previous bet is not chosen, and then submit the second bet. Accordingly, the at least one wager option described in LaNeve is not automatically responsive to the at least one patron placing the at least one first wager with the input device, but rather, requires the user to independently restart the wagering system and pick the same race parameters. Additionally, the wager option presented to the user in LaNeve will only include the at least one runner if the user chooses the same runner, not automatically responsive to the user placing the first wager with the at least one runner. As such, LaNeve does not expressly or inherently describe automatically responsive to the at least one patron placing the at least one first wager with the input device, the at least one patron is presented with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race displayed on the display element by selecting the at least one wager option with the input device.

Since LaNeve does not expressly or inherently describe each and every element of claim 33, Applicant respectfully requests withdrawal of the anticipation rejection of this claim.

Regarding claims 35 through 39, these claims depend from claim 33 which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 34 through 39 are allowable

ENTRY OF AMENDMENTS

The amendments to claims 26 and 29 through 33 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 26, 28 through 33, and 35 through 39 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

Belinda A. Suwe
Registration No. 61,239
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: August 3, 2010
BAS/jrj:lhs